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REMARKS

Applicant appreciates the Examiner's review of the above-identified patent application and respectfully requests reconsideration and allowance in view of the above amendments and following remarks. Applicant also appreciates the Examiner's granting of a telephone interview with Applicant's Representative, Paul J. Kroon, Jr., Esq., on May 3, 2004. Claims 1-20 are pending and claims 16-20 have been withdrawn. Claims 1-15 have been rejected.

Claims 1-3, 10 and 13-15 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. With this amendment, Applicant has amended claims 1-3 and 13-15 and canceled claim 10. Accordingly, Applicant respectfully submits that the rejection of claims 1-3, 10 and 13-15 has been overcome and should be withdrawn.

Claims 1-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson et al. (U.S. Patent No. 5,096,759, hereinafter referred to as "Simpson") in view of McGroarty et al. (U.S. Patent No. 5,079,088, hereinafter referred to as

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"McGroarty") and in further view of Kennepohl et al. (U.S. Patent No. 4,079,158, hereinafter referred to as Kennepohl). Applicant respectfully traverses this rejection.

During this interview between the Examiner and Applicant's Representative, Paul J. Kroon, Jr., Esq., on May 3, 2004, the Examiner stated that amending the independent claims to recite, granules "contacting the upper surface of said asphalt composition", would likely define over the prior art of record.

With this amendment, Applicant has amended independent claims 1 and 14 as suggested by the Examiner. Applicant respectfully submits that the combination of Simpson and Kennepohl does not disclose or suggested these elements in this relationship.

Amended, independent claims 1 and 14 now recite, granules "contacting the upper surface of said asphalt composition" and that said asphalt composition saturates the substrate and coats "a portion of said upper surface of said substrate." Accordingly, the granules are contacting the **same asphalt composition** that saturates and coats the substrate. Applicant respectfully submits that the combination of Simpson and Kennepohl does not disclose or suggest these comments, in this relationship, as suggested by the Examiner in the Office Action dated January 20, 2004.

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On page 5, paragraph 10 of the Office Action dated January 20, 2004 (hereinafter referred to as, the present Office Action), the Examiner points to the combination of the underlayment 90 and the roofing membrane 10 as disclosed in Simpson (in particular to the non-woven polyester mat 92 of the underlayment 90 and bitumen layer 24 of the roofing membrane 10) as reading upon the "substrate" and the "asphalt composition" as recited in a independent claim 1. Applicant notes that Simpson does not disclose or suggest a non-woven polyester mat having a bitumen layer coating a **top surface** of the non-woven polyester mat **except when** the entire roofing membrane 10 (with all of its elements except the release paper 26) is **applied over** the entire underlayment 90 (with all of its elements).

Later, on page 7 of the present Office Action, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the aluminum foil taught by Simpson et al. with the granules taught by Kennepohl et al. since Kennepohl et al. teach the use of the granules as a reflected material, as the aluminum foil taught by Simpson et al. is used as a reflective material...

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The aluminum layer 18 as disclosed in Simpson, however, is not "contacting the upper surface of said asphalt composition" as recited in independent claim 1. In contrast, Simpson specifically discloses that the roofing material 10 includes an aluminum foil sheet 18 that is "adhesively bonded to a polyethylene sheet 20 ... by an ionomer resin adhesive 22." (See Simpson, column 3, lines 16-18.) The polyethylene sheet 20 of the roofing material 10 is then adhered by the bitumen layer 24 to the non-woven polyester mat 92 of the underlayment 90 when the roofing material 10 is combined with the underlayment 90. (See Simpson, column 5, lines 55-62.) More specifically, the aluminum foil sheet 18 contacts the ionomer resin adhesive 22, which is in turn contacts the polyethylene sheet 20, which is in turn contacts the bitumen layer 24, which in turn contacts the non-woven polyester mat 92. Therefore, the aluminum foil sheet 18 does not contact to an upper surface of the asphalt composition (bitumen layer 24), but rather is adhered to the upper surface of ionomer resin adhesive 22. The ionomer resin adhesive 22 does not saturate or coat the non-woven polyester mat 92.

Accordingly, even if the combination of the roofing membrane 10 and underlayment 90, as disclosed in Simpson, was modified, as

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suggested by the Examiner, to change the aluminum layer 18 to a layer of granules as disclosed in Kennepohl, the resulting combination of Simpson and Kennepohl would still not disclose or suggest "granules contacting the upper surface of said asphalt composition on said decorative surface area" wherein said asphalt composition saturates the substrate and coats "a portion of said upper surface of said substrate to form a decorative surface area" as recited in independent claim 1. In contrast, the resulting combination of the roofing membrane 10 and underlayment 90 modified as suggested by the Examiner would include, at best, a layer of roofing granules contacting a top surface of an ionomer resin adhesive 22, a polyethylene sheet 20 contacting a bottom surface of the ionomer resin adhesive 22, a bitumen layer 24 contacting a bottom surface of the polyethylene sheet 20, and a non-woven polyester mat 92 contacting a bottom surface of the bitumen layer 24.

Therefore, Applicant respectfully submits that the rejection of independent claim 1 is improper and should be withdrawn. Because claims 2-13 depend from independent claim 1, and the rejection of claims 2-13 is based on the same references as the rejection of independent claim 1, Applicant submits that the

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rejection of claims 2-13 is also improper and should be withdrawn for at least the reasons discussed above with respect to independent claim 1.

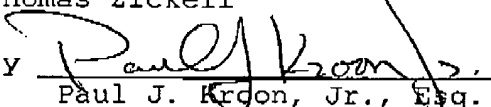
Independent claim 14 has been rejected on the same basis as independent claim 1. Accordingly, Applicant also submits that the rejection of independent claim 14, and dependent claim 15, is improper and should be withdrawn for the reasons stated above with respect to independent claim 1.

Accordingly, Applicant respectfully submits that all pending claims are in condition for allowance. Early and favorable action is respectfully requested. The Examiner is invited to telephone the undersigned, Applicant's Attorney of Record, to facilitate advancement of the present application.

Respectfully submitted,

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By


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